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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,996	01/25/2001	Seung-Hyun Nahm	5000-1-156	5422

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EXAMINER
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MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,996

Applicant(s)

NAHM, SEUNG-HYUN

Examiner

Naghmeh Mehrpour

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. **Claims 1-2, 4-12**, are rejected under 35 U.S.C. 102(e) as being anticipated by Laporta et al. (US Patent Number 6,014,429).

Regarding **claims 1, 9**, Laporta inherently teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 6 lines 11-25), the method comprising the steps of:

creating a text message by said sending party in a first portable digital phone (col 9 lines 5-67, col 10 lines 1-20);

creating a plurality of optional response messages associated with said text message (col 5 lines 5-25);

forwarding said text message with said optional response messages to said receiving party over the call connection, **wherein the optional responses are stored in memory of a second portable digital phone for a provision to the receiving party thereafter**; and receiving from the receiving party a return of one of the optional response messages (col 5 lines 5-25).

Regarding **claim 2**, Laporta teaches a method further comprising the step of, upon receiving the text message, selectively choosing one of the optional response messages by the receiving party in a second portable digital phone (col 5 lines 25-35, col 6 lines 5-30).

Regarding **claim 4**, Laporta teaches a text Messaging system wherein the response messages are stored in the memory of the second phone (col 5 lines 25-35, lines 60-67, col 6 lines 1-11).

Regarding **claim 5**, Laporta teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 5 lines 5-19), the method comprising the steps of:

detecting a message having a plurality of optional response messages stored in portable digital phone of the receiving party (col 5 lines 60-67, col 6 lines 1-11), the plurality of optional response message is selectively provided by the sending party (col 5 lines 60-67, col 6 lines 1-11);

selecting one of said optional response messages by said receiving party (col 5 lines 60-67 col 6 lines 1-11),

forwarding said selected optional response message back to said sending party via said SMS channel (col 6 lines 11-67);

a text Messaging system wherein the response messages are stored in the memory of the second phone, and the plurality of optional response message is selectively provided by the sending party (col 5 lines 60-67, col 6 lines 1-25).

Regarding **claim 6**, Laporta teaches a method of wherein said optional response messages comprise a plurality of items identifying different messages to be selected by said receiving party (col 6 lines 60-67, col 6 lines 1-67).

Regarding **claim 7**, Laporta teaches a method wherein the optional message are transmitted to the receiving party by the sending party (col 6 lines 25-40).

Regarding **claim 8**, Laporta teaches a method wherein the optional message include a call-back number allowing the selected response entered by the receiving party to be transmitted back to the sending party (col 5 lines 55-67, col 6 lines 11-60).

Regarding **claim 10**, Laporta teaches a method wherein the step of storing the text message and the optional response messages in the second terminal upon the text message from the sending party via the SMS channel (col 6 lines 1-65).

Regarding **claim 11**, Laporta teaches a method further comprising the step of retrieving the text message and the optional messages for a provision to the receiving party (col 5 lines 60-67, col 6 lines 1-47).

Regarding **claim 12**, Laporta teaches a method further comprising the step of displaying the retrieved message in a display unit of the second digital terminal (col 6 lines 49-60).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 3, 13**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Laporta et al. (US Patent 6,014,429) in view of Pepe et al. (Patent Number 5,742,905).

Regarding **claims 3, 13**, Laporta fails to teach a method wherein a message of the optional response message transmitted back to the sending party includes a call-back number provide by said receiving party. However, Pepe teaches a method wherein a message of the optional response message transmitted back to the sending party includes a call-back number provide by said receiving party (col 34 lines 50-659).

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Pepe with Laporta, in order to facilitate call-back, particularly in a case where the called subscriber elects not to interrupt the existing call in response to the waiting the call.

### ***Response to Arguments***

5. Applicant's arguments filed 7/27/06 have been fully considered but they are not persuasive.

In response to the applicant's argument that Laporta does not teach "*optional response messages are stored in memory of a second portable digital phone.*"

The examiner asserts that Laporta inherently teaches the above features, because in order for the receiving party to send back the optional messages he must store them.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Laporta fails to teach a method wherein a message of the optional response message transmitted back

to the sending party includes a call-back number provide by said receiving party. However, Pepe teaches a method wherein a message of the optional response message transmitted back to the sending party includes a call-back number provide by said receiving party (col 34 lines 50-659). Therefore by combing the above teaching of Pepe with Laporta, facilitating call-back, particularly in a case where the called subscriber elects not to interrupt the existing call in response to the waiting the call.

### **Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any responses to this action should be mailed to:**



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro be reached (571) 272-7876.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

August 9, 2006



MELODY KENTOUR  
PATENT EXAMINER